

DT05 23 SEP 2002

PATENT 717901.16
EXPRESS MAIL EL493159739US

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of: William Plenderleith)
U. S. Patent Application Serial Number: 09/989,351)
U.S. Filing Date: November 20, 2001)
PCT No.: PCT/GB00/01926)
International Filing Date: May 22, 2000)
Priority Data: May 22, 1999)
(U.K. Patent No. 9911843.2))
For: SPORTS VEHICLE)
Attorney Docket: 717901.16)

Assistant Commissioner for Patents
Attn: BOX PCT
Washington, D.C. 20231

Examiner: Unknown.
Group Art Unit: 3618
Confirmation No. 1758
Customer No. 27128

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GROUP 3600

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OFFICE OF PETITIONS

INTRODUCTION:

The Applicant's Petition to correct a mere clerical error that prevented the entering of the national phase for the above patent application by utilizing the wrong transmittal form was dismissed without prejudice on July 23, 2002.

STATEMENT OF FACTS:

A standard patent application transmittal was inadvertently utilized. The standard patent application transmittal that was inadvertently utilized by the Applicant could only be utilized with the filing of a new nonprovisional patent application under 37 C.F.R. Section 1.53 (b) "(See Exhibit A, which is hereby attached). The Applicant only filed a preliminary amendment, which must amend a prior patent application and cannot be deemed a new patent application.

Therefore, the only clear indication that can be derived from the use of this transmittal is that the wrong transmittal was utilized.

Moreover, there are only three forms listed on the United States Patent Office Website related to the PCT " (See Exhibit B, which is hereby attached). The first form is for filing a continuation or divisional of an international application." (See Exhibit C, Form PTO/SB/13/PCT, which is hereby attached). As highlighted, the United States Patent Office requires that with this Form, the mandatory inclusion of a patent specification, claims and drawings. Although a preliminary amendment can be included to amend the specification, claims or drawings, a preliminary amendment cannot be filed by itself as a continuation application. Therefore, not only was this recommended transmittal not used for a continuation application but the recommend transmittal requires the filing of the specification, claims or drawings and precludes the filing of a preliminary amendment by itself.

The preliminary amendment filed by the Applicant is specifically directed to Box PCT, United States Designated/ Elected Office (DO/EO/US) (See Exhibit D). No patent applications filed under 37 C.F.R. Section 1.53, may be filed at Box PCT, United States Designated/ Elected Office (DO/EO/US). Applicant did not provide the U.S. Patent Office with any authorization to remove this correspondence from Box PCT.

The other two forms, as shown in Exhibit B provide a petition for revival of an international patent application where the Applicant either unavoidable or unintentionally abandons the international patent application and files nothing within the requisite time period and is completely dilatory. Therefore, the rectification of national phase filing status to a patent application is fully sanctioned by the United States Patent Office and is awarded as a matter of course under United States Statutes and Rules.

POINTS TO BE REVIEWED:

1. Can a new patent application be filed under 37 C.F.R. Section 1.53 by only filing a preliminary amendment?

2. Can a bypass continuation patent application of a International PCT application be filed with only a preliminary amendment when the United States Patent Offices' own transmittal

form mandates the filing of a specification, claims and drawings with only the **optional** inclusion of an **additional** preliminary amendment?

3. Is there any ambiguity regarding the applicant's intent when there are two places to receive an indication of intent regarding treatment of the correspondence with the first indication of intent was that the preliminary amendment is specifically addressed to Box PCT, United States Designated/ Elected Office (DO/EO/US), which only allows the filing of a preliminary amendment for a national phase patent application and the second potential indication of intent was the transmittal that mandated the filing of **new** patent application under 37 C.F.R. Section 1.53 (b), which is clearly and completely erroneous on its face when only a preliminary amendment is filed?

4. Should the Applicant, because of his status as a foreign citizen, suffer an undue hardship and prejudice due to the loss of PCT national phase status? The Applicant will be required to provide a certified copy of the Great Britain Patent No. 9911843.2, as well as a certified copy of the PCT Application No. PCT/GB00/01926, which is very prejudicial against this foreign individual since a similar requirement is not required for a PCT national phase application since the certified copy of this Great Britain Patent, has already been filed. Also, it is not required of U.S. citizens regarding co-pending U.S. patent applications. There is also a separate PCT definition for unity of invention that is also more liberal than that found under United States Regulations so that by proceeding under U.S. Regulations will also pose a severe detrimental hardship to this Foreign Applicant.

ACTION REQUESTED:

Treatment of U.S. Application Patent Serial No. 09/989,351 as a U.S. national phase patent application of International Patent Application No. PCT/GB00/01926 is respectfully requested.

DISCUSSION:

When all provisions under 35 U.S.C. 371 have been complied with, the Applicant should not be unjustly deprived of national phase filing status. All aspects of 35 U.S.C. 371 have been

meet including the fee, the copy of the international application (already provided) and an amendment.

There are two (2) possible places to determine the intent of the Applicant regarding this patent application. The first and primary indication of intent is that the preliminary amendment was **specifically addressed to Box PCT, United States Designated/ Elected Office (DO/EO/US)** (See Exhibit D). Box PCT, under Official Gazette Notices dated February 5, 2002 is “only for mail related to applications filed under the Patent Cooperation Treaty.”

The second potential indication of intent is the transmittal, inadvertently used by the Applicant. This transmittal specifically requires and mandates that it “**can only be used a new patent application** under 37 C.F.R. Section 1.53 (b)” (See Exhibit A). Since only a preliminary amendment was filed, this is a clear and unambiguous indication that this transmittal was in error and provides no indication of intent to file a bypass continuation patent application, which is the only other possible option. The United States Patent Office requires on their authorized transmittal when filing a bypass continuation, see Exhibit C, Form PTO/SB/13/PCT, the mandatory inclusion of a specification, claims and drawings. Although a preliminary amendment is listed as an optional element that may be checked as being included to amend the specification, claims or drawings, it is clear that it may not be filed **in lieu of** the specification, claims or drawings.

Therefore, upon even a cursory review of all of the facts and circumstances in this situation, the desire by the Applicant to file a national phase patent application is absolutely clear and completely unambiguous with no conflicting instructions. A transmittal can only be used with a new patent application is utterly meaningless when only a preliminary amendment is filed. A preliminary amendment, by definition, must actually amend a preexisting document.

The other two national phase PCT forms provided by the U.S. Patent Office, as shown in Exhibit B, provide a petition for revival of an international patent application where the Applicant either unavoidable or unintentionally abandons the international patent application and files nothing within the requisite time period and is completely dilatory. Therefore, it is respectfully believed that the rectification of national phase filing status for a patent application is fully sanctioned by the United States Patent Office as well as the U.S. statutes and regulations and is awarded as a matter of course.

In this case, there is full compliance with all aspects of 35 U.S.C. 371. However, even assuming, arguendo, that there was not full compliance and the national phase patent application was abandoned, the Applicant can simply file a petition stating the abandonment was unintentional and revive the patent application as a mere matter of course. This will result in two pending patent applications covering the same exact subject matter. This is barred by the United States Patent Office and the Courts as **double patenting** under U.S. statutes and regulations as outlined in the Manual of Patent Examining Procedure Chapter 804 as well as under 35 U.S.C. Sections 101 and 121.

Therefore, since the United States Patent Office provides correction of virtually every type of error and irregularity, there is no reason not to convey national filing status on this patent application. This includes correction of inventorship, correction of a filing date, and so forth. The United States Patent Office even allows for filing of missing pages of a patent application and missing drawings at a later date, while providing the Applicant with the filing date of the few papers that were initially filed.

It is respectfully believed that there is sufficient cause since the Applicant is a foreign citizen, so that loss of U.S. national phase status will require a certified copy of the Great Britain Patent No. 9911843.2 and PCT International Application PCT/GB00/01926, which operates as an extreme hardship and is very prejudicial against this foreign individual since a similar requirement is not required for the U.S. national phase patent application since a copy has already been filed with the PCT International Application PCT/GB00/01926. Also, it is not required of U.S. citizens with regard to co-pending patent applications that were filed in the United States. Moreover, the standard for unity of invention is much more liberal under the PCT Regulations than under U.S. Regulations, which could also provide a hardship for this Foreign Applicant. It is respectfully believed that constitutional issues are raised when similarly situated applicants are treated differently based on their country of origin.

CONCLUSION:

The undersigned respectfully submits that the present application should have U.S. national phase filing status. Upon review of the preliminary amendment identification heading and the transmittal document, the Applicant clearly and unequivocally expressed his intent to have a U.S. national phase patent application. The preliminary amendment was specifically

addressed to Box PCT, United States Designated/Elected Office (DO/EO/US), which only accepts PCT patent applications and not U.S. bypass continuation patent applications. There is a separate PCT continuation application transmittal that was not used. The filing of a continuation application based on an international application requires the mandatory filing of a specification, claims and drawings and the addition of a preliminary amendment is an **optional added element**. There is no provision for the filing of a preliminary amendment in lieu of a specification, claims and drawings on the standard form provided by the United States Patent Office. **A transmittal that is mandated for use only with a new nonprovisional patent application under 37 C.F.R. Section 1.53 (b) is completely meaningless when used with a preliminary amendment, which by definition can only modify an existing patent application.**

Also, since an applicant who completely ignores the filing deadline for a PCT application can file a petition that explains that the delay was unintentional and easily receives a U.S. national phase application should not be in a superior position to an applicant who has fully complied with 35 U.S.C. Section 371 by filing all requisite items within the requisite time period.

Moreover, the loss of U.S. national phase status for this Foreign Applicant will operate as an extreme hardship by requiring a certified copy of a foreign patent application, which the Applicant has already provided as part of the international application process. It is also very prejudicial to this Applicant since similarly situated U.S. Applicants claiming priority from copending U.S. patent applications are not under this same requirement. This also applies to the unity of invention standard, which is more liberal under the Patent Cooperation Treaty than under U.S. law and will operate to this Foreign Applicant's extreme prejudicial detriment.

Therefore, Applicant respectfully requests that this patent application be rightfully treated as a U.S. national phase patent application. If a telephone conference would facilitate resolving any issue related to this petition, the undersigned attorney for Applicant would appreciate and welcome such a telephone conference. The attorney for Applicant may be contacted as provided below.

Respectfully submitted,

Dated: September 23, 2002

Kevin M. Kercher
Registration No. 33,408
Blackwell Sanders Peper Martin L.L.P.
720 Olive Street, 24th Floor
St. Louis, MO 63101
(314) 345-6249
Attorney for Applicant

MO
Signature
USA
use the facsimile

EXHIBIT A

PTO/SB/18 (08-02)

Please type a plus sign (+) inside this box

Approved for use through 10/31/2002. OMB 0651-0032

U.S. Patent and Trademark Office; U.S. DEPARTMENT OF COMMERCE

Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it displays a valid OMB control number.

**UTILITY
PATENT APPLICATION
TRANSMITTAL**

Only for new nonprovisional applications under 37 CFR 1.53(b))

APPLICATION ELEMENTS

(MPEP chapter 600 concerning utility patent application contents.)

Attorney Docket No.	717901.16
First Named Inventor	PLENDERLEITH, William
Title	SPORTS VEHICLE
Express Mail Label No.	EJ445151987US

ADDRESS TO: Assistant Commissioner for Patents
 Box Patent Application
 Washington, DC 20231

<input checked="" type="checkbox"/> Fee Transmittal Form (e.g., PTO/SB/17) <small>(Submit an original, and a duplicate for fee processing)</small>		7. <input type="checkbox"/> CD-ROM or CD-R in duplicate, large table or Computer Program <small>(Appendix)</small>
<input checked="" type="checkbox"/> Applicant claims small entity status. <small>See 37 CFR 1.27</small>		8. Nucleotide and/or Amino Acid Sequence Submission <small>(if applicable, all necessary)</small>
3. <input checked="" type="checkbox"/> Specification [Total Pages 16] <small>(preferred arrangement set forth below, MPEP 1503.01)</small> <ul style="list-style-type: none"> - Descriptive title of the invention - Cross Reference to Related Applications - Statement Regarding Fed sponsored R&D - Reference to sequence listing, a table, or a computer program listing appendix - Background of the Invention - Brief Summary of the Invention - Brief Description of the Drawings (if filed) - Detailed Description - Claim(s) - Abstract of the Disclosure 		a. <input type="checkbox"/> Computer Readable Form (CRF) b. Specification Sequence Listing on: <ul style="list-style-type: none"> i. <input type="checkbox"/> CD-ROM or CD-R (2 copies); or ii. <input type="checkbox"/> paper c. <input type="checkbox"/> Statements verifying identity of above copies
ACCOMPANYING APPLICATION PARTS		
9. <input type="checkbox"/> Assignment Papers (cover sheet & document(s)) 10. <input type="checkbox"/> 37 CFR 3.73(b) Statement <input checked="" type="checkbox"/> Power of Attorney <small>(when there is an assignee)</small>		
11. <input type="checkbox"/> English Translation Document (if applicable)		
12. <input checked="" type="checkbox"/> Information Disclosure Statement <input checked="" type="checkbox"/> Copies of IDS Citations <small>(IDS)/PTO-1449</small>		
13. <input checked="" type="checkbox"/> Preliminary Amendment		
14. <input checked="" type="checkbox"/> Return Receipt Postcard (MPEP 503) <small>(Should be specifically itemized)</small>		
15. <input type="checkbox"/> Certified Copy of Priority Document(s) <small>(if foreign priority is claimed)</small>		
16. <input type="checkbox"/> Nonpublication Request under 35 U.S.C. 122 <small>(b)(2)(B)(i). Applicant must attach form PTO/SB/35 or its equivalent.</small>		
17. <input checked="" type="checkbox"/> Other: <u>Check for \$388.00</u>		

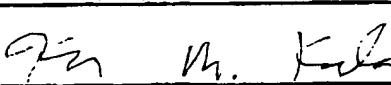
18. If a CONTINUING APPLICATION, check appropriate box, and supply the requisite information below and in a preliminary amendment, or in an Application Data Sheet under 37 CFR 1.76.

Continuation Divisional Continuation-in-part (CIP) of prior application No.: _____ / _____

Prior application information: Examiner _____ Group Art Unit: _____

For CONTINUATION or DIVISIONAL APPS only: The entire disclosure of the prior application, from which an oath or declaration is supplied under Box 5b, is considered a part of the disclosure of the accompanying continuation or divisional application and is hereby incorporated by reference. The incorporation can only be relied upon when a portion has been inadvertently omitted from the submitted application parts.

19. CORRESPONDENCE ADDRESS

<input checked="" type="checkbox"/> Customer Number or Bar Code Label		Correspondence address below			
Name	27128				
	PATENT TRADEMARK OFFICE				
Address	720 Olive Street 24 th Floor				
City	St. Louis	State	Missouri	Zip Code	63101
Country	United States	Telephone	314-345-6000	Fax	314-345-6060
Name (Print/Type) Kevin M. Kercher		Registration No. (Attorney/Agent)			33,408
Signature 			Date	November 29, 2001	
			11/29/01		

Burden Hour Statement: This form is estimated to take 0.2 hours to complete. Time will vary depending upon the needs of the individual case. Any comments on the amount of time you are required to complete this form should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, Washington, DC 20231. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Assistant Commissioner for Patents, Box Patent Application, Washington, DC 20231.

EXHIBIT B

Patent Cooperation Treaty Related Forms			>> Access to more Patent Cooperation Treaty (PCT) forms on PCT site
PTO/SB/13pct		2000/10	Request for Filing a Continuation or Division of an International Application [2 pages]
PTO/SB/61pct		2000/10	Petition for Revival of an International Application for Patent Designating the U.S. Abandoned Unavoidably under 37 CFR 1.137(a) [3 pages]
PTO/SB/64pct		2000/10	Petition for Revival of an International Application for Patent Designating the U.S. Abandoned Unintentionally under 37 CFR 1.137 (b) [2 pages]

EXHIBIT C

PTO/SB/13/PCT (10-00)

Approved for use through 10/31/2002. OMB 0651-0032
U.S. Patent and Trademark Office; U.S. DEPARTMENT OF COMMERCE

Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it displays a valid OMB control number.

REQUEST FOR FILING A CONTINUATION OR DIVISION OF AN INTERNATIONAL APPLICATION

DOCKET NUMBER	ANTICIPATED CLASSIFICATION OF THIS APPLICATION		PRIOR APPLICATION EXAMINER	ART UNIT
	CLASS	SUBCLASS		

Address to:

Assistant Commissioner for Patents
Washington, D.C. 20231

This is a request for filing a continuation divisional application under 37 CFR 1.53(b) of pending prior international application Number PCT _____ / _____, filed on _____ entitled _____

which designated the United States.

Note: 37 CFR 1.53(d) cannot be used to file a continuation or divisional application of an international application which has not entered the national stage.

CLAIMS	(1) FOR	(2) NUMBER FILED	(3) NUMBER EXTRA	(4) RATE	(5) CALCULATIONS
TOTAL CLAIMS (37 CFR 1.16(c))		- 20 =		x \$ _____ =	\$
INDEPENDENT CLAIMS (37 CFR 1.16(b))		- 3 =		x \$ _____ =	
MULTIPLE DEPENDENT CLAIMS (if applicable) (37 CFR 1.16(d))				+ \$ _____ =	
		BASIC FEE (37 CFR 1.16(e))		+ _____	
		Total of above Calculations =			
Reduction by 50% for filing by small entity (Note 37 CFR 1.27).					
		Total =			

1. Enclosed are the specification, claims and drawing(s).
2. Applicant claims small entity status. See 37 CFR 1.27.
3. The Commissioner is hereby authorized to charge any fees which may be required under 37 CFR 1.16 and 1.17, or credit any overpayment to Deposit Account No. _____. A duplicate copy of this sheet is enclosed.
4. A check in the amount of \$ _____ is enclosed.
5. Payment by credit card. Form PTO-2038 is attached.
6. Application Data Sheet is enclosed. See 37 CFR 1.76.
7. Amend the specification by inserting before the first line the sentence: "This application is a continuation division of international application number PCT _____ / _____, filed _____ (status, abandoned, pending, etc.)."

[Page 1 of 2]

Burden Hour Statement: This form is estimated to take 0.5 hours to complete. Time will vary depending upon the needs of the individual case. Any comments on the amount of time you are required to complete this form should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, Washington, DC 20231. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Assistant Commissioner for Patents, Washington, DC 20231.

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REQUEST FOR FILING A CONTINUATION OR DIVISION OF AN INTERNATIONAL APPLICATION

8. A declaration under 37 CFR 1.63 is enclosed.
9. Priority of foreign application number _____, filed on _____ in _____ is claimed under 35 U.S.C. 119(a)-(d).
 - The certified copy is enclosed.
10. A preliminary amendment is enclosed.
11. Also enclosed: _____

Address all future correspondence to: (May only be completed by applicant, or attorney or agent of record).

WARNING: Information on this form may become public. Credit card information should not be included on this form. Provide credit card information and authorization on PTO-2038.

Date

Signature

Typed or printed name

- Inventor(s)/Applicant(s)
- Assignee of the entire interest. See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed. (Form PTO/SB/96).
- Attorney or agent of record
- Filed under 37 CFR 1.34(a)
Registration number if acting under 37 CFR 1.34(a). _____

NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required.
Submit multiple forms if more than one signature is required, see below*.

Total of _____ forms are submitted.

EXHIBIT D

PATENT
717901.16

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of William Plenderleith :
Application No.: Unknown : Examiner: Unknown
Filed: Herewith : Group Art Unit: Unknown
PCT No.: PCT/GB00/01926 : Attorney Docket No.: 717901.16
International Filing Date: 22 May 2000 : Customer No.: 27,128
Priority Data: 22 May 1999 (Great Britain) : Confirmation No.: Unknown
For: SPORTS VEHICLE :

Box PCT
United States Designated/Elected Office (DO/EO/US)
Commissioner for Patents
Washington, D.C. 20231

PRELIMINARY AMENDMENT

Sir:

Prior to examination, it is respectfully requested that the application be amended as follows:

Please delete the entire specification.

Please replace with the following substitute Specification in compliance with 37 C.F.R. Section 1.125(b):

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